

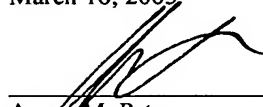
PATENT

THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Applicant : BEAULIEU, Nicole )  
Ser. No. : 10/073,598 )  
Filed : February 11, 2002 )  
Title : Automated Selection of Video )  
Gaming Options )  
Art Unit : 3714 )  
Examiner : Mosser, Robert E. )

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March 16, 2005

  
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Registration No. 48,801  
Attorney for Applicant

**APPEAL BRIEF**

Mail Stop Appeal Brief - Patents  
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Sir:

This appeal brief is submitted pursuant to the Notice of Appeal filed January 26, 2005 in connection with the present application.

**(1) REAL PARTY IN INTEREST**

The real party in interest is IGT, the assignee of rights in the present application via an assignment recorded in the Patent Office at Reel 012789, Frame 0108.

**(2) RELATED APPEALS AND INTERFERENCES**

There are no related appeals or interferences.

**(3) STATUS OF CLAIMS**

All claims in the application, claims 1-45 stand rejected. The claims are reproduced in the Appendix set forth below.

**(4) STATUS OF AMENDMENTS**

No amendment of the claims was made subsequent to the final rejection.

## (5) SUMMARY OF INVENTION

The invention is directed to a gaming apparatus and method which enables a person to request the gaming apparatus to make an automated selection from among a plurality of user-selectable options.

Referring to Fig. 18 and page 27, lines 8-9 of the present application, a player may be presented with multiple player-selectable options. Referring to Fig. 2A and page 10, lines 9-11, a button 84 may be provided to allow the player to make a request for a controller 100 to make an automated selection from among the player-selectable options. Referring to Fig. 6 and page 16, lines 22-24, the player-selectable options may include poker card hold/draw options. For example, as disclosed on page 16, line 25 through page 17, line 20, the automated selection of poker cards to hold/discard may be random or may include an educated choice. The educated choice may be in accordance with game parameters, such as strategy decisions and game rules. For instance, the controller 100 may select between an attempt for a straight or an attempt for a flush. The controller 100 may discard the appropriate cards to preserve the attempt for a straight or a flush rather than randomly selecting any of the cards presented. The player may be given the opportunity to review the selection by the controller 100 and make any desired changes.

Referring again to Fig. 18 and page 27, lines 8-13, the player may be presented with the choice of allowing the controller 100 to make a selection or to make a selection without the assistance of the controller 100. Referring to Fig. 18 and page 27, lines 13-15, in response to the player using the automated selection, the controller 100 automatically selects one or more of the player-selectable options, which may be done randomly.

## (6) ISSUE

Whether A Prima Facie Case Has Been Made That Independent Claims 1, 12, 23, 33 and 41 Are Anticipated By U.S. Patent No. 6,093,102 to Bennett.

## (7) ARGUMENT

It is respectfully submitted that a *prima facie* case of anticipation of independent claims 1, 12, 23, 33 and 41 has not been made.

### A. A Prima Facie Case of Anticipation of Claims 1, 12 and 23 Has Not Been Made.

Claim 1 is directed to a gaming apparatus which includes, *inter alia*:

said controller being programmed to receive data relating to a request from said person made during said occurrence of said wagering game for said controller to make

an automated selection from among a plurality of user-selectable options presented to said person,

said controller being programmed to make an automated selection from among said plurality of user-selectable options in response to said request,

As indicated above, claim 1 is directed to a gaming apparatus that includes a controller programmed to receive data relating to a request from a person. The request is for the controller to make an automated selection from among a plurality of user-selectable options presented to the player. In response to the request, the controller is programmed to make an automated selection from among the plurality of user-selectable options.

In the final Office Action, claim 1 was rejected under 35 U.S.C. §102 as being anticipated by U.S. Patent No. 6,093,102 to Bennett. In support of the rejection, the final Office Action states that Bennett discloses “a controller selecting a gaming option automatically from a plurality of user-selectable options if the user requests the controller to do so through not selecting an option (Col. 4:30-33)”. (Office Action dated 9/30/04, pp. 2-3).

Specifically, the cited portion of Bennett reads:

“In the embodiment of FIG. 2, the selection would default to the centre line position in the event that no symbol was selected in a particular column.”

It is respectfully submitted that this excerpt of Bennett does not disclose the claimed features as noted above because the selection is not made in response to a request made by a person as recited in Claim 1.

In response to the applicant’s previous arguments that Bennett does not anticipate the claims, the final Office action states the following on page 7:

“... the choice of a player not to select an option may be well understood as the player requesting the automatic selection. The heart of the issue is the fact that both systems provide an automated selection based on the actions (and equivalent lack of action) by the user, hence providing equivalent function as so claimed.”

The final Office Action implicitly admits that Bennett does not disclose receiving data relating to a request by stating that Bennett discloses a controller selecting a gaming option based on a user not selecting an option. The final Office action goes on to reason that action is equivalent to lack of action. In other words, the final Office Action interprets the gaming machine of Bennett as responsive to a lack of action, whereas the gaming apparatus of claim

1 is responsive to action. As a result, the final Office Action implicitly admits that Bennett discloses a feature directly opposite that of the gaming apparatus recited in claim 1.

It is clear from the language quoted above in Bennett, and from the final Office Action's admission, that Bennett makes a default selection in the absence of receiving data relating to a request by a person. However, claim 1 recites "said controller being programmed to receive data relating to a request from a user" and "said controller being programmed to make an automated selection from among said plurality of user-selectable options in response to said request." Since Bennett discloses defaulting to a center line position in the absence of a selection, it necessarily does not disclose receiving data relating to a request and making an automated selection from among user-selectable options, as the controller of claim 1 is programmed to do.

It is further submitted that the final Office Action has not made a *prima facie* case of anticipation because the final Office Action uses an erroneous standard for determining anticipation. Instead of pointing out where Bennett discloses receiving data relating to a request by a person for a controller to automatically select a user-selectable option, the final Office Action concludes that an action by the user is equivalent to a lack of action by the user as long as the resulting function is the same. In effect, the final Office action attempts to introduce "equivalency of function" as a new standard for anticipation. However, equivalent function is not the standard for anticipation.

In order for a claim to be anticipated under § 102, the anticipating reference must disclose at least one embodiment that incorporates all of the claimed elements. See, for example, C.R. Bard, Inc. v. M3 Systems, 48 U.S.P.Q.2d 1225, 1230 (Fed. Cir. 1998)("When the defense of lack of novelty is based on a printed publication that is asserted to describe the same invention, a finding of anticipation requires that the publication describe all of the elements of the claims, arranged as in the patented device")(emphasis added); In re Bond, 15 U.S.P.Q.2d 1566, 1567 (Fed. Cir. 1990)("For a prior art reference to anticipate in terms of 35 U.S.C. § 102, every element of the claimed invention must be identically shown in a single reference... These elements must be arranged as in the claim under review...")(emphasis added).

In order to find that a prior art patent "discloses" a feature, that feature must be disclosed either expressly or inherently. The standard for inherency is strict. Section 2112 of the M.P.E.P. sets forth the standard for inherency as follows:

The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the

inherency of that result or characteristic. In re Rijckaert, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993)(reversed rejection because inherency was based on what would result due to optimization of conditions, not what was necessarily present in the prior art); In re Oelrich, 666 F.2d 578, 581-82, 212 USPQ 323, 326 (CCPA 1981). >"To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.'" (underlining original).

Finally, during prosecution a claim is given its broadest reasonable interpretation as required by the M.P.E.P. See Section 2111 of the M.P.E.P., which states:

"During patent examination, the pending claims must be 'given \*>their< broadest reasonable interpretation consistent with the specification.' >In re Hyatt, 211 F.3d 1367, 1372, 54 USPQ2d 1664, 1667 (Fed. Cir. 2000).<"

It is respectfully submitted that it is not proper to simply ignore plain recitations in a claim, under the guise of applying the broadest reasonable interpretation.

Inv view of the forgoing, it is respectfully submitted that claim 1 is not anticipated by Bennett and that the rejection is erroneous.

Independent apparatus claims 12 and 23 each contain language that is identical to the relevant recitations of claim 1. Therefore, it is also respectfully submitted that claims 12 and 23 are not anticipated by Bennett.

**B. A Prima Facie Case of Anticipation of Claim 33 Has Not Been Made.**

Independent claim 33 is directed to a gaming method which includes, *inter alia*:

receiving data relating to a request from said person made during said occurrence of said wagering game to make an automated selection from among a plurality of user-selectable options presented to said person,  
performing an automatic selection from among said a plurality of user-selectable options presented to a person in response to said request;

It is respectfully submitted that claim 33 is not anticipated for the same reasons as set forth above for claim 1.

**C. A Prima Facie Case of Anticipation of Claim 41 Has Not Been Made.**

Independent claim 41 is directed to a memory having a computer program capable of being used in connection with a gaming apparatus which includes, *inter alia*:

a third memory portion physically configured in accordance with computer program instructions that would cause the gaming apparatus to receive data relating to a request from said person made during said occurrence of said wagering game for said controller to make an automated selection from among a plurality of user-selectable options presented to said person,

a fourth third memory portion physically configured in accordance with computer program instructions that would cause the gaming apparatus to perform an automated selection from among said a plurality of user-selectable options presented to said person in response to said request;

It is respectfully submitted that claim 41 is not anticipated for the same reasons as set forth above for claim 1.

**(8) CONCLUSION**

For the foregoing reasons, it is respectfully submitted that a *prima facie* case of anticipation of the claims on appeal has not been made. Appellant therefore requests that the rejection of the claims be reversed.

Respectfully submitted,

MARSHALL, GERSTEIN & BORUN LLP

March 16, 2005

By:



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## APPENDIX

1. A gaming apparatus, comprising:
  - a display unit that is capable of generating video images;
  - a value input device;
  - a controller operatively coupled to said display unit and said value input device, said controller comprising a processor and a memory operatively coupled to said processor,
    - said controller being programmed to allow a person to make a wager on an occurrence of a wagering game,
    - said controller being programmed to receive data relating to a request from said person made during said occurrence of said wagering game for said controller to make an automated selection from among a plurality of user-selectable options presented to said person,
    - said controller being programmed to make an automated selection from among said plurality of user-selectable options in response to said request,
    - said controller being programmed to cause a video image to be generated on said display unit, said video image representing a game selected from the group of games consisting of video poker, video blackjack, video slots and video bingo,
    - said video image comprising an image of at least five playing cards if said game comprises video poker,
    - said video image comprising an image of a plurality of simulated slot machine reels if said game comprises video slots,
    - said video image comprising an image of a plurality of playing cards if said game comprises video blackjack,
    - said video image comprising an image of a bingo grid if said game comprises video bingo, and
    - said controller being programmed to determine a value payout associated with an outcome of said game.

2. A gaming apparatus as defined in claim 1, wherein said controller is programmed to allow said person a choice of making a selection from among said user-selectable options or to instruct said controller to make said automated selection.

3. A gaming apparatus as defined in claim 1, wherein said controller is programmed to allow said person an opportunity to change said automated selection by at least one of a manual selection by the player and an automated selection by said controller.

4. A gaming apparatus as defined in claim 1, wherein said controller is programmed to cause a second video image to be generated on said display unit, said second video image representing a secondary game associated with said selected game, wherein said secondary game presents a plurality of user-selectable options to said person.

5. A gaming apparatus as defined in claim 1, wherein said automated selection is a random selection.

6. A gaming apparatus as defined in claim 1, wherein said automated selection is dependent upon parameters of said selected game.

7. A gaming apparatus as defined in claim 1, wherein said user-selectable options comprise the selection of one or more of said at least five playing cards to hold if said game comprises video poker, said user-selectable options comprises whether to accept another card if said game comprises video blackjack, said user-selectable options comprise a plurality of paylines if said game comprises video slots, and said user-selectable options comprise a plurality of bingo grids if said game comprises video bingo.

8. A gaming apparatus as defined in claim 1, wherein said user-selectable option comprises the option of playing one of video poker, video blackjack, video slots and video bingo.

9. A gaming apparatus as defined in claim 1, wherein said selection of a game from said group of games is performed by said controller.



10. A gaming system comprising a plurality of gaming apparatuses as defined in claim 1, said gaming apparatuses being interconnected to form a network of gaming apparatuses.

11. A gaming system as defined in claim 10, wherein said gaming apparatuses are interconnected via the Internet.

12. A gaming apparatus, comprising:

a display unit that is capable of generating video images;

a value input device;

a controller operatively coupled to said display unit and said value input device, said controller comprising a processor and a memory operatively coupled to said processor,

said controller being programmed to allow a person to make a wager on an occurrence of a wagering game,

said controller being programmed to receive data relating to a request from said person made during said occurrence of said wagering game for said controller to make an automated selection from among a plurality of user-selectable options presented to said person,

said controller being programmed to make an automated selection from among said plurality of user-selectable options in response to said request,

said controller being programmed to cause a video image to be generated on said display unit, said video image representing a game other than video keno; and

said controller being programmed to determine, after said video image has been displayed, a value payout associated with an outcome of said game represented by said video image.

13. A gaming apparatus as defined in claim 12, wherein said controller is programmed to allow said person a choice of making a selection from among said user-selectable options or to instruct said controller to make said automated selection.

14. A gaming apparatus as defined in claim 12, wherein said controller is programmed to allow said person an opportunity to change said automated selection by at least one of a manual selection by the player and an automated selection by said controller.

15. A gaming apparatus as defined in claim 12, wherein said controller is programmed to cause a second video image to be generated on said display unit, said second video image representing a secondary game associated with said game, wherein said secondary game presents a plurality of user-selectable options to said person.

16. A gaming apparatus as defined in claim 12, wherein said automated selection is a random selection.

17. A gaming apparatus as defined in claim 12, wherein said automated selection is dependent on parameters of said game.

18. A gaming apparatus as defined in claim 12, wherein said user-selectable options comprise the selection of one or more of said at least five playing cards to hold if said game comprises video poker, said user-selectable options comprises whether to accept another card if said game comprises video blackjack, said user-selectable options comprise a plurality of paylines if said game comprises video slots, and said user-selectable options comprise a plurality of bingo grids if said game comprises video bingo.

19. A gaming apparatus as defined in claim 12, wherein said user-selectable option comprises the option of playing one of video poker, video blackjack, video slots and video bingo.

20. A gaming apparatus as defined in claim 12, wherein said selection of a game from said plurality of games is performed by said controller.

21. A gaming system, comprising a plurality of gaming apparatuses as defined in claim 12, said gaming apparatuses being interconnected to form a network of gaming apparatuses.

22. A gaming system as defined in claim 21, wherein said gaming apparatuses are interconnected via the Internet.

23. A gaming apparatus, comprising:

a display unit that is capable of generating video images;

a value input device;

a controller operatively coupled to said display unit and said value input device, said controller comprising a processor and a memory operatively coupled to said processor,

said controller being programmed to allow a person to make a wager on an occurrence of a wagering game,

said controller being programmed to allow a person to make a payline selection,

said controller being programmed to receive data relating to a request from said person made during said occurrence of said wagering game for said controller to make an automated selection from among a plurality of user-selectable options presented to said person,

said controller being programmed to make an automated selection from among said plurality of user-selectable options in response to said request,

said controller being programmed to cause a video image to be generated on said display unit, said video image comprising a plurality of simulated slot machine reels of a slots game, each of said slot machine reels having a plurality of slot machine symbols, and

said controller being programmed to determine a value payout associated with an outcome of said slots game, said controller being programmed to determine said value payout based on at least one of a configuration of said slot machine symbols and display of a particular slot machine symbol.

24. A gaming apparatus as defined in claim 23, wherein said controller is programmed to allow said person an option of making a selection from among said user-selectable options or to instruct said controller to make said automated selection.

25. A gaming apparatus as defined in claim 23, wherein said controller is programmed to allow said person an opportunity to change said automated selection by at least one of a manual selection by the player and an automated selection by said controller.

26. A gaming apparatus as defined in claim 23, wherein said controller is programmed to generate a second video image on said display unit, said second video image representing a secondary game associated with said slots game, wherein said secondary game presents a plurality of user-selectable options to said person.

27. A gaming apparatus as defined in claim 23, wherein said automated selection is a random selection.

28. A gaming apparatus as defined in claim 23, wherein said automated selection is dependent on parameters of said slots game.

29. A gaming apparatus as defined in claim 23, wherein said user-selectable options comprise a number of said paylines.

30. A gaming apparatus as defined in claim 23, wherein said user-selectable options comprise said slot machine symbols.

31. A gaming system comprising a plurality of gaming apparatuses as defined in claim 23, said gaming apparatuses being interconnected to form a network of gaming apparatuses.

32. A gaming system as defined in claim 31, wherein said gaming apparatuses are interconnected via the Internet.

33. A gaming method comprising:

causing a video image to be generated, said video image representing a game selected from the group of games consisting of video poker, video blackjack, video slots and video bingo,

said video image comprising an image of at least five playing cards if said game comprises video poker,

said video image comprising an image of a plurality of simulated slot machine reels if said game comprises video slots,

said video image comprising an image of a plurality of playing cards if said game comprises video blackjack,

said video image comprising an image of a bingo grid if said game comprises video bingo;

allowing a person to make a wager on an occurrence of a wagering game,

receiving data relating to a request from said person made during said occurrence of said wagering game to make an automated selection from among a plurality of user-selectable options presented to said person,

performing an automatic selection from among said plurality of user-selectable options in response to said request; and

determining a value payout associated with an outcome of said game.

34. A gaming method as defined in claim 33, comprising:

allowing said person at least the option of either performing an automatic selection from among a plurality of user-selectable options or making a selection from among said user-selectable options.

35. A gaming method as defined in claim 33, comprising:

allowing said person an opportunity to change said automated selection by at least one of a manual selection by the player and an automated selection.

36. A gaming method as defined in claim 33, comprising:

causing a second video image to be generated, said second video image representing a secondary game associated with said selected game, wherein said secondary game presents a plurality of user-selectable options to said person.

37. A gaming method as defined in claim 33, comprising:

randomly selecting from among said plurality of user-selectable options presented to said person.

38. A gaming method as defined in claim 33, wherein performing an automatic selection is dependent upon parameters of said selected game.

39. A gaming apparatus as defined in claim 33, comprising:  
selecting one or more of said at least five playing cards to hold if said game comprises video poker;  
accepting another card if said game comprises video blackjack;  
selecting one or more of said paylines if said game comprises video slots; and  
selecting one or more of said bingo grids if said game comprises video bingo.

40. A gaming method as defined in claim 33, comprising selecting to play one of video poker, video blackjack, video slots and video bingo.

41. A memory having a computer program stored therein, said computer program being capable of being used in connection with a gaming apparatus, said memory comprising:  
a first memory portion physically configured in accordance with computer program instructions that would cause the gaming apparatus to allow a person to make a wager on an occurrence of a wagering game;  
a second memory portion physically configured in accordance with computer program instructions that would cause the gaming apparatus to cause a video image to be generated on a display unit, said video image representing a game selected from the group of games consisting of video poker, video blackjack, video slots, and video bingo,  
said video image comprising an image of at least five playing cards if said game comprises video poker,  
said video image comprising an image of a plurality of simulated slot machine reels if said game comprises video slots,  
said video image comprising an image of a plurality of playing cards if said game comprises video blackjack,  
said video image comprising an image of a bingo grid if said game comprises video bingo,

a third memory portion physically configured in accordance with computer program instructions that would cause the gaming apparatus to receive data relating to a request from said person made during said occurrence of said wagering game for said controller to make an automated selection from among a plurality of user-selectable options presented to said person,

a fourth memory portion physically configured in accordance with computer program instructions that would cause the gaming apparatus to perform an automated selection from among said plurality of user-selectable options in response to said request; and

a fifth memory portion physically configured in accordance with computer program instructions that would cause the gaming apparatus to determine a value payout associated with an outcome of said game.

42. A memory defined in claim 41, wherein said fourth memory portion is physically configured in accordance with computer program instructions that would cause a random selection from among said plurality of user-selectable options presented to said person.

43. A memory as defined in claim 41, comprising a sixth memory portion physically configured in accordance with computer program instructions that would cause the gaming apparatus to allow said person an opportunity to change said automated selection by at least one of a manual selection by the player and an automated selection by said gaming apparatus.

44. A memory as defined in claim 41, wherein said memory comprises a sixth portion physically configured in accordance with computer program instructions that would cause the gaming apparatus to cause a second video image to be generated on said display unit, said second video image representing a secondary game associated with said selected game, wherein said secondary game presents a plurality of user-selectable options to said person.

45. A memory as defined in claim 41, wherein said fourth memory portion is physically configured in accordance with computer program instructions that would cause the

gaming apparatus to perform an automated selection that is dependent upon parameters of said selected game.





**PATENT**

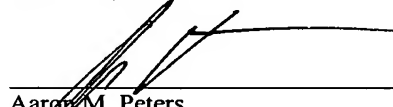
**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

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Ser. No. : 10/073,598  
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Examiner : Mosser, Robert E.

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) March 16, 2005:

)   
) Aaron M. Peters  
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**APPEAL BRIEF TRANSMITTAL**

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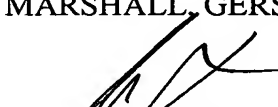
The appeal brief for the appeal taken to the Board of Patent Appeals and Interferences in connection with the present application is submitted herewith. A check in the amount of \$500.00 for the large-entity fee for filing the appeal brief under 37 C.F.R. §41.20(b)(2) is enclosed.

Respectfully submitted,

MARSHALL, GERSTEIN & BORUN LLP

March 16, 2005

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